

**REMARKS**

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Harada et al., WO 99/65095, with Harada et al., U.S. Patent No. 6,440,607, being used as a translation. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Harada et al., U.S. Patent No. 6,440,607. Applicants submit that the rejections are improper and that Harada et al. is insufficient to support a case of anticipation under 35 U.S.C. 102 for the reasons identified below.

**1) The Office has not raised a material new issue in the present action regarding the anticipation of the present application by Harada et al.**

The Harada et al. U.S. patent was cited by the Office in the first action in this application, i.e., the Action dated April 7, 2005, to reject claims 1 and 2 as being anticipated under 35 U.S.C. § 102(e) and was combined with Tani et al., U.S. Patent No. 6,649,304, to reject claims 3 and 4 as being obvious under 35 U.S.C. § 103(a). After the filing of a response to the Action, the Office issued a second office action dated September 15, 2005, and stated:

"1. The 35 U.S.C. 102(a) [sic, 102(e)] rejection of claims 1-2 anticipated by Harada et al. has been withdrawn due to applicant's argument filed 7/7/2005.  
2. The 35 U.S.C. 103(a) rejection of claims 3-4 over Harada et al. in view of Tani et al. has been withdrawn due to applicant's argument filed on 7/7/2005."

In the present action, the Office has essentially repeated the rejections made in the first action without rebutting the arguments made in the response to the first Action. In each 35 U.S.C. 102 rejection in the present action, the Office has repeated (almost verbatim) the 35 U.S.C. 102(e) rejection made in the first action. The Office has newly identified only that Harada et al. discloses that the layer comprising a hydroxide of an element is bismuth and is formed on the surface of the positive electrode active material to reject dependent claims 3 and 4 of the present application. This new issue does not affect and is immaterial to the patentability of claim 1, the sole independent claim of the application.

Applicants have previously traversed and the Office has removed the rejection of claim 1 under 35 U.S.C. 102(e) over the Harada et al. U.S. patent. The rejection in the present action of claims 1 to 4 under 35 U.S.C. 102(b) over the Harada et al. WO publication does not amount to a new rejection since 1) the Office relies on the Harada et al. U.S. patent as an accurate translation

of the Harada et al. WO publication and 2) the rejection is identical to the 35 U.S.C. 102(e) rejection.

It is improper for the Office to reject again the claims of the present application over either the U.S. patent or WO publication of Harada et al. without rebutting applicants' arguments that resulted in the withdrawal of the rejections over Harada et al. in the first action and without providing reasons for reinstating the 35 U.S.C. 102 rejection over Harada et al. Since the Office has not raised a new issue regarding the patentability of claim 1 over Harada et al., removal of the 35 U.S.C. 102 rejections of the claims is in order.

**2) The disclosure of Harada et al. is insufficient to support a case of anticipation under 35 U.S.C. 102.**

Harada et al. discloses a nickel-hydrogen secondary battery comprising a positive electrode containing a nickel compound (e.g., nickel hydroxide); a negative electrode containing a hydrogen absorbing alloy which can contain aluminum, a binder and an electrically conductive material; a separator; and an electrolyte, wherein the binder contains a carboxylated styrene-butadiene copolymer latex. Claim 1 of the present application, on the other hand, recites a nickel metal hydride storage battery comprising a

positive electrode comprising nickel hydroxide as an active material, a negative electrode comprising a hydrogen absorbing alloy containing aluminum, a separator and an alkaline electrolyte, wherein a complex-forming agent which forms a complex with aluminum is included in the negative electrode. Claim 2 recites that the complex-forming agent is an aromatic carboxylic acid.

The position of the Office in both the present action and the first action dated April 7, 2005, is that the nickel-hydrogen secondary battery of Harada et al. includes each of the elements of the nickel-hydride battery of the present invention as recited in claims 1 and 2 of the present application, the carboxylated styrene-butadiene copolymer latex contained as a binder in the negative electrode of the battery of Harada being a complex-forming agent which forms a complex with aluminum as recited in claim 1 and, more particularly, being an aromatic carboxylic acid complex-forming agent as recited in claim 2.

As first noted in the response filed July 7, 2005, to the first action dated April 7, 2005, the rejection of claims 1 and 2 is not proper. There is nothing in Harada et al. to suggest that the carboxylated styrene-butadiene copolymer latex disclosed therein functions as a complex-forming agent which forms a complex with aluminum and the Office has provided no evidence or reasoning

to show that the carboxylated styrene-butadiene copolymer latex would inherently be expected to function as a complex-forming agent which forms a complex with aluminum in the battery of Harada. The Office has the burden of initially providing such evidence or reasoning to support its case of anticipation.

Moreover, a person of ordinary skill in the art would not reasonably expect the carboxylated styrene-butadiene copolymer latex of Harada et al. to function as a complex-forming agent which forms a complex with aluminum contained in the hydrogen-absorbing alloy because a carboxylated styrene-butadiene copolymer latex as disclosed in Harada et al. is known to be a chemically stable rubber compound.

Regarding claim 2, the carboxylated styrene-butadiene copolymer latex of Harada et al. is not an aromatic carboxylic acid as required by claim 2.

The propriety of the rejections of claims 3 and 4 in the present action depends on whether the rejection of claim 1 is proper. Since, for the reasons explained above, Harada does not support the rejection of claim 1, claims 3 and 4 are *prima facie* patentable.

Removal of the rejections of the claims is in order and is respectfully requested. Issuance of a Notice of Allowability and

Notice of Allowance is also believed to be in order and is respectfully requested.

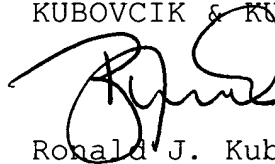
The foregoing is believed to be a complete and proper response to the Office Action dated July 20, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik  
Reg. No. 25,401

Atty. Case No. SNY-035  
The Farragut Building  
Suite 710  
900 17th Street, N.W.  
Washington, D.C. 20006  
Tel: (202) 887-9023  
Fax: (202) 887-9093  
RJK/jbf